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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,488	09/16/2003	Joseph P. Errico	SPINE 3.0-437 P P P P P P P I C	2425
530 7590 10/29/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER PELLEGRINO, BRIAN E				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
10/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,488

Applicant(s)

ERRICO ET AL.

Examiner

Brian E. Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,11-13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,11-13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/7/08 has been entered.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 120 is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: no petition was filed with the late claim for priority.

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the *first sentence(s) of the specification* following the title or in an application data sheet during the proper time frame. For benefit claims under 35 U.S.C. 120, the reference must include the proper relationship (i.e., continuation, divisional, or continuation-in-part) of the applications desired to claim priority during the permitted time frame for submitting the claim to priority. Additionally, the reference to add the

above, noted, prior-filed applications in the first sentence of the specification on page one following the title is not acceptable as drafted since it has improperly incorporated by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Thus, since the instant application is a utility application filed under 35 U.S.C. 111(a) after November 29, 2000, the specific reference must be submitted during the pendency of the application and *within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application*. This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A *benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c)*. The petition must be accompanied by (1) the reference

required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

The following Office Action contains rejections to previously allowed and/or previously objected-to-as-allowable material as indicated in Office Action mailed 3/4/08. Accordingly, the following action has been made Non-Final.

Claim Objections

Claims 5,6,11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Each of these claims depend from a canceled claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,5,6,11-12,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (6190414) in view of Hedman et al. (4759769). Fig. 10 shows an intervertebral spacer device with first and second baseplates (**158,160**) that are mounted to one another via joint **162**. It can also be seen the baseplates each include an engagement hole (**170,172**) in the inward surfaces respectively in a perimetrical region that has a single post **140** positioned within the holes of the plates. The examiner is interpreting the claimed element "engagement hole" in this way: a cavity in something solid or an opening and interpreting "tool" in this way: an operational device performing a function. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055. Thus, the Examiner interprets the "tool" to be element **156** since it has a shaft with a channel and a longitudinal axis that houses the post **140**. The post is fully capable of being entirely within the shaft in a first position and extends out to adjust the implant height in a second position. However, Young fails to teach that the baseplates include a plurality of engagement holes. Hedman et al. teach (Figs. 1,2) a spinal implant with two baseplates that is hinged and has a plurality of engagement holes **52** for a "tool" that adjusts the height. It would have been obvious to one of ordinary skill in the art to use the teaching of Hedman et al. and have a plurality of engagement holes for tools to raise or adjust the implant height with the spinal device of Young et al. such that a wider area of support can be provided between the patient's vertebrae. Regarding claims 5,5,11 the spinal device is fully capable of having the desired surgical approach

aspects. With respect to claim 16, it is noted that Young et al. does teach (Fig. 18) using three adjustable spacing tool devices. It would have been obvious to one of ordinary skill in the art to provide three engagement holes within a baseplate of Young per the teaching of Hedman to increase the coverage area between two vertebrae since such a modification only involves routine skill in the art and has predictable results. Thus, the spinal device having two baseplates disclosed by Young (Fig. 9) has been modified such that it has a greater width.

Claims 13,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. '414 in view of Hedman et al. '769 and Young et al. (3659661). Young et al. '414 is explained above. However, Young '414 fails to teach the baseplates include a plurality of engagement holes and a spring in the shaft of the tool. Hedman et al. is also explained supra. Young et al. '661 teach (Fig. 3) a jack that has a shaft **13** with an axial channel to house a spring **18** and the post **19** of the jack. Young et al. '661 also teach (col. 2, lines 58-60) that the spring is used to maintain a force to keep the jack from loosening. It would have been obvious to one of ordinary skill in the art to use a plurality of holes as taught by Hedman et al. and a spring in the shaft as taught by Young et al. '661 to modify the implant device of Young '414 in order to provide more coverage area by using a wider plate with more engagement holes in each plate and prevent any collapse via the spring.

Response to Arguments

Applicant's arguments with respect to claims 1,13,16 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M- F (9am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700
/Brian E Pellegrino/
Primary Examiner, Art Unit 3738